



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/524,110

12/05/2005

Harlan A Hurwitz

115572.01

4394

25944

7590

05/27/2009

OLIFF & BERRIDGE, PLC

P.O. BOX 320850

ALEXANDRIA, VA 22320-4850

EXAMINER

CHAMPAGNE, LUNA

ART UNIT

PAPER NUMBER

3627

MAIL DATE

DELIVERY MODE

05/27/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/524,110

**Applicant(s)**

HURWITZ ET AL.

**Examiner**

LUNA CHAMPAGNE

**Art Unit**

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 May 2006.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 and 21 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-19 and 21 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 2/10/05 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-850)  
Paper No(s)/Mail Date 2/10/05  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This action is in response to communication received on 5/9/2006. Claims 1-19, and 21 are submitted for examination. Claims 20, 22-160 are cancelled.

#### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 2, 8-13 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101.

*Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.*

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-19, 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Nichtberger et al. (Re. 34,915).

Re claims 1, 14, 21, Nichtberger et al. disclose a method of electronically managing payment media in a retail store, the method comprising: automatically determining the possibility of providing a proposed payment media management solution in response to a payment media processing request; and providing the proposed payment media management solution, if possible, in response to the request, wherein the proposed payment media management solution includes one or more of at least a start fund solution, a payment media change dispensing solution, a payment media advance solution, a bank deposit solution, a coupon redemption solution and a payment media acceptance operation solution, wherein a retail store includes one or more of at least a single store, multiple stores, one or more third party concession

stands located within a single store and two or more stores located within a mall (*see e.g. col. 17, lines 54-67; col. 29, lines 26-30*).

Re claim 2, Nichtberger et al. disclose a method, wherein the request is provided by an operator in a retail store (*see e.g. col. 28, lines 39-44*).

Re claims 3, 4, 17, Nichtberger et al. disclose a method wherein the request is automatically provided by a controller in response to instructions stored on a machine-readable storage medium (*see e.g. col. 29, lines 47-50; col. 28, lines 1-3*); a method wherein the step of automatically determining the proposed payment media management solution is performed based on one or more of at least a group of rules stored in a lookup table, instructions provided for a retail store, instructions provided by an entity other than a retail store, and instructions based on real time or substantially real time analysis of payment media activity information that is electronically obtained in a retail store during a predetermined period of time (*see e.g. col. 29, lines 47-50*).

Re claims 5, 18, Nichtberger et al. disclose a method wherein the group of rules considers one or more of at least one of retailer type, retailer size, retailer location, type of payment media originating device where the proposed payment media management solution is to be provided, the specific payment media originating device for which the proposed payment media management solution distribution is requested, time of day for the proposed payment media management solution distribution, calendar date for the

proposed payment media management solution distribution, calendar date of national or local holidays, calendar date of scheduled festivities or organized events, and a retail store scheduled sales event (*see e.g. col. 19, lines 45-47*).

Re claims 6, 19, Nichtberger et al. disclose payment media activity information including an electronic point of sale (EPOS) data (*electronic cash register see e.g. col. 3, lines 34-37 – electronically collected data – see e.g. col. 18, lines 31-32*), payment media information from an automatic teller machine located in a retail store ( *see e.g. col. 3, lines 34-37 – automated checkout system*), a value of payment media in a retail store (*coupon discount value see e.g. col. 22, line 67*).

Although Nichtberger et al. do not explicitly disclose the payment media refund amount information, frequency and size of payment media refunds processed within a predetermined period of time, payment media information from a third party payment media redemption machine located in a retail store, a denomination of payment media in a retail store, media type and payment media pickup or delivery information scheduled by a cash-in-transit operator, it is considered a obvious variation of Nichtberger et al. to include this type of information, in order to broaden the system.

Re claim 7, Nichtberger et al. disclose a method wherein the instructions provided by the entity other than a retail store are provided to a retail store via a communication network (*see e.g. col. 29, lines 51-55; col. 27, lines 64-65*).

Re claim 8, Nichtberger et al. disclose a method wherein the step of determining the proposed payment media management solution requires no additional input other than the payment media processing request (*see e.g. col. 24, lines 39-50*).

Re claims 9, 10, Nichtberger et al. disclose a method further comprising: modifying the proposed payment media management solution based on further input; where the further input is from a retail store operator requesting the payment media management solution (*see e.g. col. 22, lines 45-48; Notice that a card has been inserted to start the process. It is understood that either the customer or the retail store operator could insert the card into the unit as described in col. 5, lines 19-27*).

Re claim 11, Nichtberger et al. disclose a method wherein a plurality of the proposed payment media management solutions are simultaneously provided for a plurality of operators in a retail store (*see e.g. col. 5, lines 3-6 – local stations 10*).

Re claims 12, 15, Nichtberger et al. disclose a method wherein one or more proposed payment media management solutions are provided for at least one payment media originating source (*see e.g. col. 5, lines 28-33 coupons are redeemed*).

Re claims 13, 16, Nichtberger et al. disclose a method wherein the at least one payment media originating source comprises one or more of at least a retail till, a

retailer back office, a coin redemption device and a third party retail concession (*see e.g. col. 17, lines 57-58 – the cash register terminal*).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LUNA CHAMPAGNE whose telephone number is (571)272-7177. The examiner can normally be reached on Monday - Friday 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on (571) 272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Luna Champagne/  
Examiner, Art Unit 3627

/F. Ryan Zeender/  
Supervisory Patent Examiner, Art Unit 3627